

REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1, 2, 4-16 and 45-54; the only claims pending and currently under examination in this application.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 2, 4-16, and 45-54 were provisionally rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Cattell (U.S. Patent Application Publication No. 2002/0102559).

The MPEP § 2136.05 states, "When a prior U.S. patent, U.S. patent application publication, or international application publication is not a statutory bar, a 35 U.S.C. 102(e) rejection can be overcome by . . . submitting an affidavit or declaration under 37 CFR 1.132 establishing that the relevant disclosure is applicant's own work. *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969)."

The Examiner noted that the applied reference has a common inventor with the instant application, and suggested that the reference may be overcome by a declaration under 37 CFR § 1.132 that the invention disclosed but not claimed in the reference was derived from the inventor of the instant application, and is thus not the invention "by another." Applicants have submitted herewith a proper declaration under 37 CFR § 1.132, asserting that the inventor of the applied reference is not "by another", and respectfully request that the rejection of Claims 1, 2, 4-16, and 45-54 under 35 U.S.C. § 102(e) be withdrawn.

Claims 1, 2, 4-16, and 47-54 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Cattell (U.S. Patent No. 6,180,351).

Similar to the previous rejection, the Examiner noted that the applied reference has a common inventor with the instant application, and suggested that the reference may be overcome by a declaration under 37 CFR § 1.132 that the invention disclosed but not claimed in the reference was derived from the inventor of the instant application, and is thus not the invention "by another." The Applicants

have submitted herewith a proper declaration under 37 CFR § 1.132, asserting that the inventor of the applied reference is not “by another”, and respectfully request that the rejection of Claims 1, 2, 4-16, and 47-54 under 35 U.S.C. § 102(e) be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 2, 4-16, and 47-54 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Perttunen et al. (U.S. Patent No. 5,968,728) in view of Ellison et al. (U.S. Patent Application Publication No. 2002/0086319 A1).

In order to meet its burden in establishing a rejection under 35 U.S.C. § 103 the Office must first demonstrate that the combined prior art references teach or suggest all the claimed limitations. *See Pharmastem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342 (Fed. Cir. 2007) (“the burden falls on the patent challenger to show by clear and convincing evidence that a person of ordinary skill in the art would have had reason to attempt to make [every element of] the composition or device, or carry out the [entire] claimed process, and would have had a reasonable expectation of success in doing so,” (*citing KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007))); and *see Omegaflex, Inc. v. Parker-Hannifin Corp.*, 2007 U.S. App. LEXIS 14308 (Fed. Cir. 2007) (“[t]he Supreme Court recently explained that ‘a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art,’” (*citing KSR Int’l Co.* at 1741)); and *see Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006) (“[once] all claim limitations are found in a number of prior art references, the factfinder must determine ‘[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references,’” (*citing In re Fulton*, 391 F.3d 1195, 1199-1200 (Fed. Cir. 2004))).

The rejected claims include the element of “automatically selecting one or more machine readable algorithms for how to read an array or machine readable algorithms for how to process data from an array following reading of the array based on said retrieved array related data”. Additionally, the rejected claims include

the element of "reading said array according to an algorithm of said one or more automatically selected machine readable algorithms to obtain data".

The Examiner alleges that Perttunen substantially discloses the Applicants' presently claimed invention. However, the Examiner concedes that Perttunen does not teach shipping the fabricated array and forwarding the array related data to a remote location. Office Action, pg. 13, section 6, ¶ 2. Thus, to remedy the deficiencies of Perttunen, the Examiner attempts to rely upon the teachings of Ellison.

The Applicants respectfully disagree and contend that the cited references fail to disclose the claimed element of "automatically selecting one or more machine readable algorithms for how to read an array or machine readable algorithms for how to process data from an array following reading of the array based on said retrieved array related data". Perttunen discloses as follows:

Embodiments of the present invention provide a molecular detection device having an arrangement of molecular receptors which is concealed or obscured. As a result, molecular structures in a sample applied to the molecular detection device are obscured or concealed with knowledge of hybridization information alone. To deduce the molecular structures in the sample, the hybridization information is processed in conjunction with data indicating the arrangement of the molecular receptors. The data can be stored in a member retained by an end user to restrict the ability of others to deduce the molecular structures in the sample. Alternatively, the data can be stored in a database that provides limited access thereto.

Perttunen, col. 2, lines 34-47. Thus, Perttunen actually discloses that data is "retained by an end user to restrict the ability of others to deduce the molecular structures in the sample." Perttunen, col. 2, lines 34-47. Therefore, Perttunen does not disclose or suggest the element of "automatically selecting one or more machine readable algorithms for how to read an array or machine readable algorithms for how to process data from an array following reading of the array based on said retrieved array related data", as claimed by the Applicants.

Additionally, the Examiner alleges that Perttunen “teaches that the user, at a user location retrieve[s] (sic) array related data (e.g. mapping) and selects machine readable algorithms (e.g. instructions) (Column 3, lines 45-67 and Fig. 2) for reading data and processing the data read by the user (Column 5, lines 7-20 and Column 7, line 40–Column 8, line 67).” Office Action, pg. 20, lines 9-12.

The Applicants respectfully disagree and contend that the cited references fail to disclose the claimed element of “reading said array according to an algorithm of said one or more automatically selected machine readable algorithms to obtain data”. Perttunen merely discloses that “particular sites at which hybridization occurs are detected, and data representative of the hybridization results are stored.”

Perttunen, col. 8, lines 45-47. Additionally, Perttunen discloses as follows:

Advantageously, one or more molecular structures in the sample are unidentifiable based on the hybridization results alone, i.e. without knowledge of the mapping. By retaining the second portion **130** having the data **132** indicative of the mapping, the end user restricts the ability of others to deduce molecular structures in the sample based on the hybridization results.

Perttunen, col. 8, lines 48-54. Moreover, Perttunen actually discloses that, “The end user allows an individual to deduce information based on binding results by providing the member [i.e., second portion **130**] to the individual. The end user inhibits an individual to deduce the information by withholding the member [i.e., second portion **130**] from the individual.” Perttunen, col. 9, line 65 to col. 10, line 2. Thus, Perttunen only discloses detecting hybridization results, and then deducing information based on binding results. Consequently, Perttunen does not disclose or suggest the element of “reading said array according to an algorithm of said one or more automatically selected machine readable algorithms to obtain data”, as claimed by the Applicants.

As Ellison was cited solely for its alleged disclosure of a method including shipping the array and forwarding the array related data to a remote location, Ellison fails to remedy the deficiencies of Perttunen discussed above.

Therefore, for the reasons stated above, a *prima facie* case of obviousness has not been established because the cited combination of Perttunen and Ellison fails to teach or suggest every element of the rejected claims. Accordingly, the Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 1, 2, 4-16, and 47-54 be withdrawn.

Claims 45-46 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Perttunen et al. (U.S. Patent No. 5,968,728) in view of Ellison et al. (U.S. Patent Application Publication No. 2002/0086319 A1) and further in view of Zelany et al. (U.S. Patent No. 6,215,894). As set forth above, Perttunen is deficient in that it fails to disclose or suggest the claimed elements of “automatically selecting one or more machine readable algorithms for how to read an array or machine readable algorithms for how to process data from an array following reading of the array based on said retrieved array related data”, and “reading said array according to an algorithm of said one or more automatically selected machine readable algorithms to obtain data”. Ellison was cited solely for its alleged disclosure of a method including shipping the array and forwarding the array related data to a remote location. Zelany was cited solely for its alleged disclosure of the use of control probes. Consequently, both Ellison and Zelany fail to remedy the deficiencies of Perttunen discussed above. Therefore, the cited combination of references does not disclose or suggest all the elements of Claims 45-46, and the Applicants respectfully request withdrawal of this rejection.


CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 327-3400.

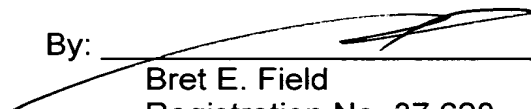
The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

Date: February 11, 2008

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Enclosure:

- Declaration of Herbert F. Cattell under 37 C.F.R. § 1.132

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